

REMARKS

In the Office Action dated November 28, 2007, claims 18-21 were rejected under 35 U.S.C. § 101; claims 1, 3-5, 8, 11, 13, 18-22, and 25-33 were rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent Application Publication No. 2004/0176104 (Arcens) in view of U.S. Patent Application Publication No. 2001/0009544 (Vanttinen); claim 9 was rejected under 35 U.S.C. § 103(a) as unpatentable over Arcens and Vanttinen, and further in view of Application's admitted prior art, U.S. Publication No. 2004/0180655 (Applicant's "admitted prior art"); claims 12 and 14 were rejected under 35 U.S.C. § 103(a) as unpatentable over Arcens and Vanttinen, and further in view of Applicant's "admitted prior art;" claims 15-17 were rejected under 35 U.S.C. § 103(a) as unpatentable over Arcens in view of Vanttinen, and U.S. Patent No. 6,195,557 (Havinis); and claim 23 was rejected under 35 U.S.C. § 103(a) as unpatentable over Arcens and Vanttinen, and further in view of Havinis.

REJECTION UNDER 35 U.S.C. § 101

Claims 18-21 were rejected under § 101 because the Office Action asserted that “an article comprising ...” “is a nonfunctional descriptive material, and does not define any structural and functional interrelationships between the claimed elements which permit functionality to be realized.” 11/28/2007 Office Action at 3.

Applicant respectfully disagrees with this assessment, as claim 18 is related to an article of manufacture that includes at least one storage medium that contains instructions that when executed cause a mobile station to perform the recited tasks. Thus, there clearly exists both structural and functional interrelationships between the claimed elements and the underlying hardware, *i.e.*, the mobile station. Since claim 18 is directed to subject matter that provides a practical application, claim 18 recites statutory subject matter.

The Office Action stated that “nowhere in the specification is there language of ‘article of manufacture.’” Applicant also respectfully disagrees with this assertion. Claim 18 recites at least one **storage medium** that contains instructions that when executed cause a mobile station in the wireless communications network to perform the recited tasks. The at least one storage medium of claim 18 is an example of an article of manufacture. In fact, specific examples of such storage media are provided in ¶ [0059] of the present Specification.

Therefore, reversal of the § 101 rejection is respectfully requested.

REJECTION UNDER 35 U.S.C. § 103

a. Rejection Over Arcens and Vanttinen

Independent claim 1 was rejected as being obvious over Arcens in view of Vanttinen. It is respectfully submitted that the obviousness rejection is defective.

To make a determination under 35 U.S.C. § 103, several basic factual inquiries must be performed, including determining the scope and content of the prior art, and ascertaining the differences between the prior art and the claims at issue. *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 U.S.P.Q. 459 (1965). Moreover, as the U.S. Supreme Court held, it is important to identify a reason that would have prompted a person of ordinary skill in the art to combine reference teachings in the manner that the claimed invention does. *KSR International Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1741, 82 U.S.P.Q.2d 1385 (2007).

Here, it is respectfully submitted that even if Arcens and Vanttinen were to be hypothetically combined, their hypothetical combination would not have led to the claimed subject matter. As recognized by the Office Action, Arcens fails to disclose communicating, to the mobile station, a paging message containing an indication of whether the paging message is related to at least one of an emergency-related location service and a law enforcement-related location service, where the indication has a first state to indicate that the paging message is related to at least one of the emergency-related location service and the law enforcement-related location service. 11/28/2007 Office Action at 4. However, the Office Action relied upon Vanttinen as disclosing the communication of a paging message.

A problem with the citation of Vanttinen as disclosing claimed subject matter that is not present in Arcens is that the paging message of Vanttinen does **not** contain an indication of whether the paging message is related to at least one of an emergency-related location service and a law enforcement-related location service. Therefore, even if Arcens and Vanttinen were to be hypothetically combined, the hypothetical combination would still be missing the following element of claim 1: a paging message containing an indication of whether the paging message is related to at least one of an emergency-related location service and a law enforcement-related location service.

Therefore, it is respectfully submitted that the obviousness rejection is defective for at least this reason.

Moreover, it is clear that there existed no reason to combine the teachings of Arcens and Vanttinen. More specifically, there existed no reason to substitute the location request (which is a non-paging message) of Arcens with the paging message of Vanttinen. Note that the mobile station 102 of Arcens contains a location application block 114, which can be self-contained and does not require interaction with an external network, or alternatively, may involve interaction with an external location request application 108 (*see* Fig. 1 at ¶ [0023] of Arcens). In the latter context, where a location request is received from the external application 108, such a location request is an application-to-application location request. This form of location request that involves communication of data between different applications (one in the mobile station, and another one external to the mobile station) would clearly not involve data carried in a paging message. In fact, since communication of application-level data is involved in Arcens, the location request sent by the external location request application 108 to the mobile station 102 would have to be carried as traffic, and more particularly, as traffic in a traffic channel (and not a paging message) of a wireless network to the mobile station of Arcens. In view of this, a person of ordinary skill in the art clearly would not have been prompted to replace the location request of Arcens with a paging message, as doing so would likely defeat the intended purpose of Arcens, which involves an application-to-application communication of application traffic.

In view of the foregoing, since no reason existed to combine the teachings of Arcens and Vanttinen, it is respectfully submitted that the obviousness rejection is further defective for this additional reason.

In view of the foregoing, it is respectfully submitted that claim 1 is non-obvious over Arcens and Vanttinen.

Independent claims 22 and 27 are allowable over the cited references for similar reasons.

Independent claim 8 was also rejected as being obvious over Arcens and Vanttinen. With respect to claim 8, the Office Action conceded that Arcens fails to disclose communicating a paging message containing an indication of whether the paging message is related to at least one of an emergency-related location service and a law enforcement-related location service, where communicating the paging message includes sending a paging request containing the indication from a mobile switching center to a base station. 11/28/2007 Office Action at 9. Instead, the

Office Action relied upon Vanttinen as disclosing the communication of such a paging message.
Id.

The hypothetical combination of Arcens and Vanttinen would not have led to the claimed subject matter. Vanttinen does not disclose claimed subject matter that is missing from Arcens; namely, Vanttinen does not disclose or hint at communicating a paging message containing an indication of whether the paging message is related to at least one of an emergency-related location service and a law enforcement-related location service, where the paging message is a paging request sent from a mobile switching center to a base station.

Therefore, the hypothetical combination of Arcens and Vanttinen would not have led to the claimed subject matter. Moreover, for reasons stated above, a person of ordinary skill in the art would not have been prompted to combine the teachings of Arcens and Vanttinen to achieve the claimed invention.

Therefore, the obviousness rejection of claim 8 is defective.

Independent claim 18 was also rejected as being purportedly obvious over Arcens and Vanttinen. As an initial note, the rejection of claim 18 is defective for at least the reason that the Office Action has referred to language that does not appear in claim 18. Specifically, on page 18, the Office Action stated that Arcens “does not specifically disclose communicating a paging message to the mobile station,” in the context of the rejection of claim 18. Note that claim 18 does not recite communicating a paging message. Therefore, the statement in the Office Action, in connection with claim 18, that Vanttinen discloses the communicating of a paging message to a mobile station is irrelevant.

The obviousness rejection of claim 18 is also defective based on mis-application of Arcens to a claim element. Contrary to the assertion by the Office Action, Arcens clearly fails to disclose receiving messaging to cause the mobile station to move to a traffic channel in response to a callback by at least one of an emergency services entity and a law enforcement entity (as recited in claim 18). As purportedly disclosing this element of claim 18, the Office Action cited element 202 in Fig. 2(a) of Arcens, where the Office Action stated that element 202 “represents a state during which the privacy engine 120 awaits reception of a request for location data information (*i.e.*, a position request).” 11/28/2007 Office Action at 10. Waiting for a position request does **not** “cause the mobile station to move to a traffic channel in response to a callback

by at least one of an emergency services entity and a law enforcement entity,” as recited in claim 18.

Since the hypothetical combination of Arcens and Vanttinen would not have led to the claimed subject matter, it is respectfully submitted that the obviousness rejection is defective for at least this reason. Moreover, for reasons stated above, a person of ordinary skill in the art would not have been prompted to combine the teachings of Arcens and Vanttinen to achieve the claimed invention.

Dependent claims are allowable for at least the same reasons as corresponding independent claims. In view of the defective obviousness rejection of base claims over Arcens and Vanttinen, it is respectfully submitted that the obviousness rejections of dependent claims over Arcens, Vanttinen, and other references have also been overcome.

b. Rejection Over Arcens, Vanttinen, and Havinis

Independent claim 15 was rejected as being obvious over Arcens, Vanttinen, and Havinis.

In the rejection of claim 15, the Office Action also conceded that Arcens fails to disclose receiving of the paging message as recited in claim 15. 11/28/2007 Office Action at 25. Instead, the Office Action cited Vanttinen and Havinis as disclosing the claimed subject matter not present in Arcens.

As explained above, Vanttinen clearly fails to disclose a paging message that contains an indication that the paging message is related to at least one of the emergency-related location service and the law enforcement-related location service. Havinis also fails to provide such teaching. Therefore, even if Arcens were to be hypothetically combined with Vanttinen and Havinis, it is respectfully submitted that the hypothetical combination of the references would not have led to the claimed subject matter.

Therefore, the obviousness rejection of claim 15 is defective. Moreover, since no reason existed to combine the teachings of Arcens and Vanttinen, a person of ordinary skill in the art would also not have been prompted to combine Arcens, Vanttinen, and Havinis.

c. Conclusion

Dependent claims are allowable for at least the same reasons as corresponding independent claims.


In view of the defective obviousness rejection of base claims, it is respectfully submitted that the obviousness rejections of dependent claims are also defective.

Allowance of all claims is respectfully requested. The Commissioner is authorized to charge any additional fees and/or credit any overpayment to Deposit Account No. 20-1504 (NRT.0118US).

Respectfully submitted,

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